

RECEIVED
CENTRAL FAX CENTER

JUL 14 2004

AMIN & TUROCY, LLP

FACSIMILE

THIS MESSAGE IS INTENDED ONLY FOR THE USE OF THE INDIVIDUAL OR ENTITY TO WHICH IT IS ADDRESSED AND MANY CONTAIN INFORMATION THAT IS PRIVILEGED, CONFIDENTIAL AND EXEMPT FROM DISCLOSURE UNDER APPLICABLE LAW. IF THE READER OF THIS MESSAGE IS NOT THE INTENDED RECIPIENT OR THE EMPLOYEE OR AGENT RESPONSIBLE FOR DELIVERING THE MESSAGE TO THE INTENDED RECIPIENT, YOU ARE HEREBY NOTIFIED THAT ANY DISSEMINATION, DISTRIBUTION OR COPYING OF THIS COMMUNICATION IS STRICTLY PROHIBITED. IF YOU HAVE RECEIVED THIS COMMUNICATION IN ERROR, PLEASE NOTIFY US IMMEDIATELY, AND RETURN THE ORIGINAL MESSAGE TO US AT THE ADDRESS LISTED BELOW VIA UNITED STATES MAIL. THANK YOU.

Date: 7/14/2004

TO: Examiner Stephen Hong

OFFICIAL

FACSIMILE NO.: **703-872-9306**

FROM: Casey Martin
AMIN & TUROCY, LLP
24th Floor, National City Center
1900 East 9th Street
Cleveland, Ohio 44114

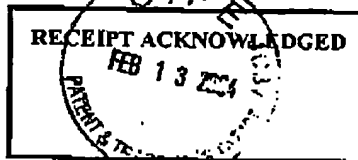
Telephone: (216) 696-8730
Facsimile: (216) 696-8731

No. of Pages Including Cover 13

Applicant(s) Sommerer Docket No. MS131787.1/MSFTP284US
Serial No. 09/410,644 Filing Date 10/1/99 Atty(s) HSA
Title BALANCED VIEW GENERATION FOR ELECTRONIC...
Mailed 2/10/04 Due Date 2/10/04 Exp. Mail No. _____

- ☐ Patent Application (☐ New ☐ CON ☐ DIV ☐ CIP ☐ CPA ☐ PCT ☐ Provisional)
- ☐ Transmittal/Request ☐ Declaration/POA ☐ Issue Fee Transmittal
- ☐ Pages of Specification ☐ Assgn. & Cover Sheet ☐ Main. Fee Transmittal
- ☐ Sheets of Drawings ☐ Small Entity Statement ☐ Ltr. Off. Draftsman
- ☐ Formal ☐ Informal ☐ IDS/1449/Refs. ☐ Notice of Appeal
- ☐ Pages of Abstract ☐ Priority Documents ☒ Appeal Brief
- ☐ Express Mail Certificate
- ☐ Amendment/Response ☐ Check \$ _____
- ☐ Transmittal ☐ Ext. of Time
- ☐ Trademark/Service App.
- ☐ Specimens ☐ St. of Use

Other: _____



DOCKETED
C.P. / HSA
FEB 20 2004

PATENT

MS131787.1

CERTIFICATE OF MAILING

I hereby certify that this correspondence (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-14501.

Date: 2/10/04

Heather Holmes
Heather Holmes

**RECEIVED
CENTRAL FAX CENTER**

JUL 14 2004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

Applicant(s): Ralph Sommerer

Serial No: 09/410,644

Filing Date: October 1, 1999

Examiner: Jonathan D. Stone

Art Unit: 2178

OFFICIAL

Title: BALANCED VIEW GENERATION FOR ELECTRONIC DOCUMENTS

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Dear Sir:

Applicant submits this brief in triplicate in connection with an appeal of the above-identified patent application. Please charge \$330.00 for the fee associated with this brief to Deposit Account No. 50-1063[MSFTP284US].

09/410,644

MS131787.1

I. Real Party in Interest (37 C.F.R. §1.192(c)(1))

The real party in interest in the present appeal is Microsoft Corporation, the assignee of the present application.

II. Related Appeals and Interferences (37 C.F.R. §1.192(c)(2))

Appellant, appellant's legal representatives, and/or the assignee of the present application are not aware of any appeals or interferences which will directly affect, or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims (37 C.F.R. §1.192(c)(3))

Claims 1-3, 5-10, 12-15, and 17-18 are pending in the subject application. The rejection of claims 1-3, 5-10, 12-15, and 17-18 is appealed.

IV. Status of Amendments (37 C.F.R. §1.192(c)(4))

Independent claims 1, 10 and 15 were amended and claims 4, 11 and 16 were cancelled in the Reply to the Final Office Action. The Examiner, in Paper No. 14, stated that the amendments will be entered upon filing the subject brief.

V. Summary of Invention (37 C.F.R. §1.192(c)(5))

The subject invention relates to systems and methods that balance lines of text in an electronic document without forcing text onto a previous or a next page. (p.3, ll.17-19). The system and methods utilize a rolling pair of lines technique, wherein a line of text is balanced and then succeeding lines of text are balanced one-by-one until the last line of text on a page is reached. (p.3, ll.20-22, p.10, ll.4-6). To balance a respective line of text, a length of the line of text is compared with a length of a succeeding line of text. (p.4, ll.3-5, p.8, ll.20-21). If the length of the line of text is greater than the length of a succeeding line of text, the line of text is adjusted, for example, by moving a last word of the line of text to the first word of the succeeding line of text, if the adjustment meets predetermined criteria. (p.4, ll.5-8, p.9, ll.3-15). Upon balancing the line of text, the length of the succeeding line of text is compared to a length of a next line of text. (p.7, ll.5-7, p.10, ll.4-5). By mitigating forcing text onto the previous or next page during balancing, pages of an electronic document can be rebalanced without affecting

09/410,644

MSI31787.1

pagination; and, thus, balancing can be employed independent of pagination, which provides advantages over conventional techniques. (p.4, ll.9-14).

VI. Statement of the Issues (37 C.F.R. §1.192(c)(6))

A. Whether claims 1-3, 5-10, 12-15, and 17-18 are unpatentable under 35 U.S.C. §103(a) over Edel, *et al.* (US 4,891,771) in view of Truelson (US 6,223,191).

VII. Grouping of Claims (37 C.F.R. §1.192(c)(7))

For the purposes of this appeal only, the claims are grouped as follows:

Claims 1-3, 5-10, 12-15, and 17-18 stand or fall together.

VIII. Argument (37 C.F.R. §1.192(c)(8))

A. Rejection of Claims 1-3, 5-10, 12-15, and 17-18 Under 35 U.S.C. §103(a)

Claims 1-3, 5-10, 12-15, and 17-18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Edel, *et al.* (US 4,891,771) in view of Truelson (US 6,223,191). Withdrawal of the rejection is respectfully requested for at least the following reasons. Edel, *et al.* and Truelson, individually or in combination, do not teach or suggest all the claim limitations.

i. *Applicable law*

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, *the prior art reference (or references when combined) must teach or suggest all the claim limitations.* See MPEP §706.02(j). (Emphasis added)

09/410,644

MS131787.1

- ii. ***Edel, et al. does not teach or suggest each and every element as recited in claims 1-3, 5-10, 12-15, and 17-18; thus, Edel, et al. does not make obvious the subject claims.***

The subject invention relates to systems and methods that balance lines of text in an electronic document on a rolling pair of lines basis without forcing text onto a previous or a next page in order to provide a balanced view. Independent claims 1, 7, 9, 10, 14, and 15 recite system and method that balance text on a page on *a rolling pair of lines-by-rolling pair of lines basis*. As disclosed in the subject application, balancing text on a rolling pair of lines-by-rolling pair of lines basis includes determining whether a length of a first line of text is greater than the length of a *succeeding* line of text; and, if the length of the first line of text is greater than the length of the succeeding line of text, then the first line of text is adjusted (e.g., by moving a last word of the first line of text to the first word of the succeeding line of text), if the adjustment meets predetermined criteria. Edel, et al. does not teach or suggest such novel aspects.

In the Final Office Action (dated June 27, 2003), the Examiner concedes "Edel, et al. ... [does] not explicitly teach determining if a first line is less than a second line in length." (See Final Office Action, p.3, No. 8). Moreover, there is no teaching, suggestion or motivation in Edel, et al. to modify the reference to result in applicant's invention absent utilizing applicant's specification as a 20/20 hind-sight based roadmap to provide the necessary motivation - the mere fact that the reference can be modified does not render the modification obvious unless the referenced art also suggests the desirability of the modification. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Accordingly, Edel, et al. does not make obvious the subject claims.

- iii. ***Truelson, et al, fails to make up for the aforementioned deficiencies of Edel, et al. with respect to claims 1-3, 5-10, 12-15, and 17-18 of the subject invention; therefore, Edel, et al. in view of Truelson, et al. fails to make obvious the subject claims.***

In the Final Office Action, it is contended that Truelson makes up for the deficiencies of Edel, et al. with respect to comparing a length of a first line of text with a length of *succeeding* line of text to balance lines of text in an electronic document. In particular, it is contended that Truelson discloses a data structure with line length information and that it would have been

09/410,644

MS131787.1

obvious to one of ordinary skill in the art at the time of the invention to modify Truelson to extract such information and compare the lengths of two lines in order to provide another means to determine if a word segment should be moved from a line. However, the mere fact that the reference can be modified does not render the modification obvious unless the referenced art also suggests the desirability of the modification. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Furthermore, a teaching or suggestion to make the claimed combination and a reasonable expectation of success must both be found in the prior art, not in applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Truelson provides no motivation, suggestion or desirability to utilize such a comparison for balancing text on a rolling pair of lines-by-rolling pair of lines basis as recited in the subject claims. Rather, Truelson discloses balancing lines of text based on a set of a *preceding* (not succeeding) balanced line(s) and then determining final group balancing based on an aggregate weight of the *preceding* balanced lines of text.

In contrast, the subject claims recite balancing on a rolling pair of lines-by-rolling pair of lines basis, which requires balancing a line of text based on a *succeeding* line of text (e.g., determining whether the length of a first line of text is greater than / less than the length of a next line of text). Thus, it appears that the Examiner is modifying the reference via employment of applicant's specification on a 20/20 hindsight (blueprint) based reading to provide this missing teaching. *Interconnect Planning Corporation v. Thomas E. Feil, Robert O. Carpenter, V Band Systems, Inc., and Turret Equipment Corp.*, 774 F.2d 1132, 1138 (C.A.Fed. 1985.); 227 USPQ 543 (stating the invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time). *See also Stewart-Warner Corp. v. City of Pontiac, Michigan*, 767 F.2d 1563, 1570 (Fed.Cir.1985), 226 USPQ 676, 680-81. The rationale proffered to modify and combine Edel, *et al.* and Truelson is to achieve benefits identified in applicant's specification. Applicant's representative respectfully submits that this is an unacceptable and improper basis for a rejection under 35 U.S.C. §103. In essence, this rejection is based on an assertion that it would have been obvious to do something not suggested in the art because so doing would provide advantages stated in applicant's specification. This sort of rationale has been condemned by the Court of Appeals for the Federal Circuit. *See, for example, Panduit Corp. v. Dennison Manufacturing Co.*, 1 USPQ2d 1593 (Fed. Cir. 1987).

09/410,644

MS131787.1

It is further contended in the Final Office Action that Truelson discloses a method to determine if the letter spacing of a first line exceeds a letter spacing threshold. However, Truelson utilizes this letter spacing threshold *only* when the text is right/left justified such that the lines of text are the *same length*, and when the lines of text are the same length, comparing the length of equal length lines of text does not provide useful length difference information since the length difference is zero. Truelson further discloses that when the lines of text are left justified with a "ragged" right margin, letter space would be "omitted." (See col. 7, lines 27-30).

In view of the foregoing, it is respectfully requested that the rejection of independent claims 1, 7, 9, 10, 14 and 15 (and dependent claims 2-3, 5-6, 8, 12-13, and 17-18, which respectively depend therefrom) be withdrawn.

IX. Conclusion

For at least the above reasons, the claims currently under consideration are believed to be patentable over the cited references. Accordingly, it is respectfully requested that the rejections of claims 1-3, 5-10, 12-15, and 17-18 be reversed.

If any additional fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Respectfully submitted,
AMIN & TUROCY, LLP


ANTHONY M. DEL ZOPPO, III
Reg. No. 51,606

AMIN & TUROCY, LLP
24th Floor, National City Center
1900 East 9th Street
Telephone: (216) 696-8730
Facsimile: (216) 696-8731

09/410,644

MS131787.1

X. Appendix of Claims (37 C.F.R. §1.192(c)(9))

1. A computer-implemented method operable on a page of at least text comprising:
balancing the at least text on the page without forcing any of the at least text onto a previous page or a next page, wherein balancing the page comprises balancing the page on a rolling pair of lines-by-rolling pair of lines basis; and
outputting the page.
2. The method of claim 1, wherein outputting the page comprises displaying the page.
3. The method of claim 1, wherein outputting the page comprises storing the page for later display.
4. (Cancelled)
5. The method of claim 4, wherein balancing the page on a rolling pair of lines-by-rolling pair of lines basis comprises moving a word from a first line of a rolling pair of lines to a second line of the rolling pair of lines based on a predetermined criteria.
6. The method of claim 4, wherein balancing the page on a rolling pair of lines-by-rolling pair of lines basis comprises, for each of a series of rolling pairs of lines of the page,
determining whether a first line of the rolling pair is greater than a second line of the rolling pair in length;
upon determining that the first line of the rolling pair is greater than the second line of the rolling pair in length,
determining whether a last word of the first line would fit as a first word of the second line;
upon determining that the last word of the first line would fit as the first word of the second line,
determining whether moving the last word of the first line as the first word of the second line meets a predetermined criteria;

09/410,644

MS131787.1

upon determining that moving the last word of the first line as the first word of the second line meets the predetermined criteria,

moving the last word of the first line as the first word of the second line.

7. A computer implemented method operable on a page of at least text comprising:

balancing the at least text on the page without forcing any of the at least text onto a previous page or a next page on a rolling pair of lines-by-rolling pair of lines basis, including for at least one rolling pair of lines, moving a word from a first line of the rolling pair of lines to a second line of the rolling pair of lines based on a predetermined criteria; and,
outputting the page.

8. The method of claim 7, wherein balancing the page comprises, for each of a series of rolling pairs of lines of the page,

determining whether a first line of the rolling pair is greater than a second line of the rolling pair in length;

upon determining that the first line of the rolling pair is greater than the second line of the rolling pair in length,

determining whether a last word of the first line would fit as a first word of the second line;

upon determining that the last word of the first line would fit as the first word of the second line,

determining whether moving the last word of the first line as the first word of the second line meets the predetermined criteria;

upon determining that moving the last word of the first line as the first word of the second line meets the predetermined criteria,

moving the last word of the first line as the first word of the second line.

9. A computer-implemented method for balancing a page of at least text comprising, for each of a series of rolling pairs of lines of the page,

determining whether a first line of the rolling pair is greater than a second line of the rolling pair in length;

09/410,644

MS131787.1

upon determining that the first line of the rolling pair is greater than the second line of the rolling pair in length,

determining whether a last word of the first line would fit as a first word of the second line;

upon determining that the last word of the first line would fit as the first word of the second line,

determining whether moving the last word of the first line as the first word of the second line meets a predetermined criteria;

upon determining that moving the last word of the first line as the first word of the second line meets the predetermined criteria,

moving the last word of the first line as the first word of the second line.

10. (Currently amended) A machine-readable medium having a plurality of instructions stored thereon for execution by a processor to perform a method comprising:

balancing at least text on a page without forcing any of the at least text onto a previous page or a next page, wherein balancing the page comprises balancing the page on a rolling pair of lines-by-rolling pair of lines basis; and,

outputting the page.

11. (Cancelled)

12. The medium of claim 11, wherein balancing the page on a rolling pair of lines-by-rolling pair of lines basis comprises moving a word from a first line of a rolling pair of lines to a second line of the rolling pair of lines based on a predetermined criteria.

13. The medium of claim 11, wherein balancing the page on a rolling pair of lines-by-rolling pair of lines basis comprises, for each of a series of rolling pairs of lines of the page,

determining whether a first line of the rolling pair is greater than a second line of the rolling pair in length;

upon determining that the first line of the rolling pair is greater than the second line of the rolling pair in length,

09/410,644

MS131787.1

determining whether a last word of the first line would fit as a first word of the second line;

upon determining that the last word of the first line would fit as the first word of the second line,

determining whether moving the last word of the first line as the first word of the second line meets a predetermined criteria;

upon determining that moving the last word of the first line as the first word of the second line meets the predetermined criteria,

moving the last word of the first line as the first word of the second line.

14. A machine-readable medium having a plurality of instructions stored thereon for execution by a processor to perform a method comprising, for each of a series of rolling pairs of lines of a page of at least text,

determining whether a first line of the rolling pair is greater than a second line of the rolling pair in length;

upon determining that the first line of the rolling pair is greater than the second line of the rolling pair in length,

determining whether a last word of the first line would fit as a first word of the second line;

upon determining that the last word of the first line would fit as the first word of the second line,

determining whether moving the last word of the first line as the first word of the second line meets a predetermined criteria;

upon determining that moving the last word of the first line as the first word of the second line meets the predetermined criteria,

moving the last word of the first line as the first word of the second line.

15. An electronic device comprising:

a memory to store a page of at least text; and,

09/410,644

MS131787.1

a processor to execute a program to balance the at least text on the page without forcing any of the at least text onto a previous page or a next page, the program balances the page based in part on succeeding lines of text.

16. (Cancelled)

17. The device of claim 16, wherein the program is to balance the page on a rolling pair of lines-by-rolling pair of lines basis by moving a word from a first line of a rolling pair of lines to a second line of the rolling pair of lines bases on a predetermined criteria.

18. The device of claim 16, wherein the program is to balance the page on a rolling pair of lines-by-rolling pair of lines basis by, for each of a series of rolling pairs of lines of the page, determining whether a first line of the rolling pair is greater than a second line of the rolling pair in length;

upon determining that the first line of the rolling pair is greater than the second line of the rolling pair in length,

determining whether a last word of the first line would fit as a first word of the second line;

upon determining that the last word of the first line would fit as the first word of the second line,

determining whether moving the last word of the first line as the first word of the second line meets a predetermined criteria;

upon determining that moving the last word of the first line as the first word of the second line meets the predetermined criteria,

moving the last word of the first line as the first word of the second line.